



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,135	06/01/1999	CHRISTIAN LAROQUE	Q054622	8820

7590 12/02/2004
SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 200373213

EXAMINER

PHILPOTT, JUSTIN M

ART UNIT	PAPER NUMBER
----------	--------------

2665

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,135

Applicant(s)

LAROQUE ET AL.

Examiner

Justin M Philpott

Art Unit

2665



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to newly amended claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Specifically, applicant argues Kabay and Poon fail to disclose the new limitations to the amended claims 1-8. However, these new limitations are clearly taught by Hickey as discussed in the following action.

Claim Objections

2. Claims 10 and 11 are objected to because of the following informalities: "character string is remains" (claim 10, line 2) should be changed to "character string remains"; and "checks the signaling message with" (claim 11, line 2) should be changed to either "checks the signaling message for" or "compares the signaling message with". For the purpose of the prior art rejections in the following action, claim 11 is interpreted as "checks the signaling message for". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2665

4. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, claim 12 recites the limitation “regardless of the destination for the signaling message” and claim 13 recites the limitation “regardless of the signaling configuration of said signaling message”. Neither of these limitations are enabled by applicant’s specification.

Applicant may overcome this rejection by amending the claims to remove the above limitations. However, as amended, claims 12 and 13 would be objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Thus, claims 12 and 13 should be canceled.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 5,995,595 to Hickey et al.

Regarding claim 1, Hickey teaches a switch (e.g., ISDN telephone 12/14, see FIG. 1) comprising: a coupler (e.g., comprising network interface 42, see FIG. 3) accessing signaling

Art Unit: 2665

channels (e.g., D-channels; signaling channel 46) to transmit signaling messages (e.g., message signaling via signaling packets, see col. 3, lines 8-42); an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) producing a signaling configuration (e.g., setup message, see col. 3, line 43 – col. 4, line 5) upon receiving an order to send a signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64), the signaling configuration produced (e.g., setup message) depends on a type of the signaling channels accessible to the coupler (e.g., setup message depends on the signaling channel comprising a D-channel, see col. 3, lines 63-64); and a receiver (inherently within 12/14) for adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to a received signaling message, wherein the order (e.g., incoming call) is a predetermined constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5).

Regarding claim 3, Hickey teaches a switch as discussed above regarding claim 1, wherein the switch provides a method of sending a signaling message (e.g., message signaling via signaling packets, see col. 3, lines 8-42), comprising: adding to the signaling message a predetermined send order for the signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64), the adding further comprises the switch receiving the signaling message in a receiving exchange (e.g., see col. 3, line 22 – col. 4, line 5) and adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to the signaling message; and interpreting the send order in an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) of the switch to produce a signaling configuration (e.g., setup message, see col. 3, line 43 – col. 4, line 5) of the switch, the signaling configuration (e.g., setup message) produced depends on a type of signaling channels available to the switch (e.g., setup message depends on the

Art Unit: 2665

signaling channel comprising a D-channel, see col. 3, lines 63-64), wherein the receive flag is a specified constant (e.g., flag or code, see col. 4, lines 1-3) and the predetermined send order (e.g., incoming call) is a specified constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5).

Regarding claims 5 and 7, Hickey teaches the interpreter is configured, and comprises a circuit, to process at least a switched X25 protocol (e.g., see col. 1, lines 15-62).

Regarding claim 8, Hickey teaches the interpreter comprises one of a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4, 6 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al.

Regarding claims 2 and 4, Hickey teaches the switch and method discussed above regarding claims 1 and 3, however, may not specifically disclose a detector or translator.

Kabay also teaches a switch and a method for telecommunications, and specifically, teaches a coupler (e.g., intercept box) has a detector (e.g., implicitly done by database lookup) for recognizing whether a received signaling message is addressed to a switch (e.g., see col. 17,

Art Unit: 2665

lines 12-15), and implicitly processing the message accordingly when the switch is the destination, and a translator (implicitly via the database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) when the switch is not the destination for the signaling message (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers). The teachings of Kabay provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Regarding claim 6, as discussed above regarding claim 8, Hickey teaches the interpreter comprises one of: a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

Regarding claim 9, while Hickey in view of Kabay may not specifically disclose selecting one of a plurality of signaling channels in a chronological order, it is generally considered to be within the ordinary skill in the art to duplicate parts for a multiplied effect. St. Regis Paper Co. v. Bemis Co., Inc., 193 USPQ 8, 11 (7th Cir. 1977). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to provide for the selection of one of a plurality of signaling channels in the method and apparatus of Hickey in

Art Unit: 2665

view of Kabay since it is generally considered to be within the ordinary skill in the art to duplicate parts for a multiplied effect. Further, Examiner takes official notice that selection of a channel according to chronological order, or round-robin, is well known in the art for channel selection. Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to select signaling channels in a chronological order since such channel selection is well known in the art.

Regarding claim 10, Kabay teaches the predetermined constant character string (e.g., dialed number, or CdPN) remains unchanged regardless of a type of available signaling channels (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers). As discussed above, the teachings of Kabay provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Regarding claim 11, Hickey teaches when the signaling message is received by the switch, adding a receive flag (e.g., flag or code, see col. 4, lines 1-25) and checking the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message (e.g., see col. 4, lines 1-25 wherein upon detection of a flag, it is determined whether the call is from WAW telephone 12 and is correspondingly to be received by a WAW telephone such as WAW telephone 14).

Regarding claims 12 and 13, as discussed above regarding claim 2, Kabay teaches a translator (via database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) if the switch is not itself the destination (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers), regardless of the signaling configuration or signaling message destination. The teachings of Kabay provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,167,122 to Titmuss et al. discloses telecommunications routing based on message format, and U.S. Patent No. 6,349,133 to Matthews et al. discloses interfacing a telephony network and a digital data stream.

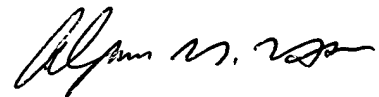
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M Philpott whose telephone number is 571.272.3162. The examiner can normally be reached on M-F, 9:00am-5:00pm.

Art Unit: 2665

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on 571.272.3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Justin M Philpott



ALPUS H. HSU
PRIMARY EXAMINER